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10/520,291

12/29/2004

Sooyoung Park

7347P001

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06/12/2008

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EXAMINER

SHIAO, REI TSANG

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

06/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/520,291 | <b>Applicant(s)</b><br>PARK ET AL. |  |
|                              | <b>Examiner</b><br>REI-TSANG SHIAO   | <b>Art Unit</b><br>1626            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Amendment of claims 1-3 and addition of claims 4-6 in the amendment filed on April 23, 2008 is acknowledged. Claims 1-6 are pending in the application. No new matter has been found. Since the newly added claims 4-6 are commensurate within the scope of the invention, claims 1-6 are prosecuted in the case.

### ***Responses to Election/Restriction***

2. Applicant's election of Group I claims 1-3, in part, in the reply filed on April 23, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-6 are pending in the application. The scope of the invention of the elected subject matter is as follows.

Claims 1-3, in part, drawn to compounds/composition of formula (I), wherein the variable R2 or R3 independently does not represent heterocycle thereof, the variable R2 or R3 independently is not substituted heterocycle thereof, the aryl or heterocycle can not condensed at the optional site thereof.

Claims 1-3, in part, embraced in above elected subject matter, are prosecuted in the case. Claims 1-3, in part, not embraced in above elected subject matter, and claims 4-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

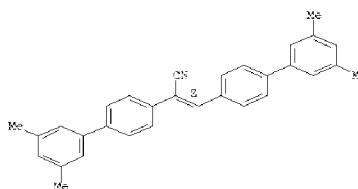
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3 are rejected under 35 U.S.C. 102(a) as being anticipated by An et al. publication, Journal of the American Chemical society, 2004, 126:10232-10233.

Applicants claim compound of formula (I), wherein the variable R1 represents



, and R2 or R3 independently represents alkyl.



An et al. disclose a compound, i.e., , see compound No. 3 on page 10232, it clearly anticipate the instant compounds of formula (I), wherein R2 or R3 independently represents alkyl (i.e., methyl). Dependent claims 2-3 are also rejected along with claim 1 under 35 U.S.C. 102(a).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148


USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

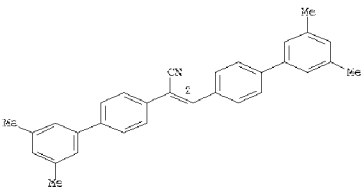
Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over An et al. publication, *Journal of the American Chemical society*, 2004, 126:10232-10233.

Applicants claim compound/electro-luminescent composition of formula (I),

wherein the variable R1 represents , and R2 or R3 independently represents alkyl.

**Determination of the scope and content of the prior art (MPEP §2141.01)**

An et al. disclose an electro-luminescent composition comprising a compound ,

i.e., , see compound No. 3 on page 10232,


**Determination of the difference between the prior art and the claims (MPEP §2141.02)**

The difference between the instant claims and An et al. is that the instant variable R2 or R3 represents alkyl or aryl, while An et al. represents alkyl (i.e., methyl) at the same position. An et al. compound/compositions overlap with the instant invention.

**Finding of prima facie obviousness-rational and motivation (MPEP §2142-2143)**

One having ordinary skill in the art would find the instant claims 1-3 prima facie obvious **because** one would be motivated to employ the compound/compositions of An et al. teachings to obtain the instant compound/electro-luminescent composition of



formula (I), wherein the variable R1 represents , and R2 or R3 independently represents alkyl. Dependent claims 2-3 are also rejected along with claim 1 under 35 U.S.C. 103(a).

The motivation to obtain the claimed methods of use derives from known An et al. compound would possess similar activity (i.e., electro-luminescent composition) to that which is claimed in the reference.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rei-tsang Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/REI-TSANG SHIAO /

Rei-tsang Shiao, Ph.D.  
Primary Patent Examiner  
Art Unit 1626

June 05, 2008